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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/353,316	07/14/99	MACOR J	MACOR8

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EXAMINER	
APPIAH,C	
ART UNIT	PAPER NUMBER
2682	9

DATE MAILED: 06/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/353,316	Macor
Examiner	**Art Unit**
Charles Appiah	2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *three* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Mar 29, 2001*

2a) ☒ This action is **FINAL.** 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-22* is/are pending in the applica

4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-22* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-9, and 16-21 have been considered but are moot in view of the new ground(s) of rejection.

2. Applicant's arguments filed on 3/29/01 with respect to claim 10 have been fully considered but they are not persuasive.

With respect to Applicant's argument that "the connection (15) in Duncan is one part of a two-part connector interface (13), while "the other part of interface (13) is a connector receptor (14) which is a wired modular connector that is a necessary part of the interface (13), . . ." and because the Duncan system necessarily contains a wired connection, Duncan does not teach, a remote data transfer system for transferring organizer data from a base station to an organizer unit while the unit is remote from the base station, examiner respectfully disagrees with Applicant and would like to draw Applicant's attention to Duncan's teaching, as readily noted by Applicant, that "a connection between an accessory item of audio telephony equipment and a telephone host may be implemented over an infrared media or wireless media" (col. 7, lines 14-20). Inasmuch as the wired modular connector may be a necessary part of the interface (13), the above teaching of Duncan that the connection may be implemented over an infrared or wireless media clearly reads on Applicant's claimed "remote data transfer system for transferring organizer data from a base

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Applicant attempts to overcome the combination of Nguyen with Duncan by attacking the references separately and saying there is no applicability between Duncan's disclosure and Nguyen's personal communication terminal because Nguyen's terminal neither requires nor justifies another data transfer system. Examiner would like to point out to Applicant that in making the combination of Nguyen and Duncan, one of ordinary skill in the art would be using Duncan's teaching of implementing a connection between an accessory item and a host over a wireless media while the accessory item and the host are separated to modify Nguyen's data transfer system for sharing information. Hence , the combination is proper and maintained as repeated below. This rejection is made **FINAL.**

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 2, 3, 4 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by **Smith, II (5,768,163)**.

With respect to claim 1, Smith discloses an integrated computer and mobile communication system (with reference to FIG. 3), comprising:

a computer base station (10),

a mobile device (12) containing a wireless telephone unit (see col. 2, lines 14-16) and a personal organizer unit (inherent feature of personal or portable computer as illustrated in Figure 2), including a display screen (see col. 3, lines 44-54), the mobile device being separable from the computer base station (see col. 2, lines 9-16) and a data transfer system for transferring data from the computer base station to the mobile device (see col. 2, lines 23-30). Smith's teaching of the display/write pad providing spontaneous use, by simplifying taking along bits of personal information such as appointments, phone number, notes and miscellaneous data files, col. 3, lines 44-49), as well as the touch buttons functioning as softkeys for user input (see col. 4, lines 47-49), reads on the claimed schedule access function keys as well as the function keys depicted in FIG. 1 reads on the access function keys and a display screen.

With respect to claim 2, Smith further discloses a keyboard for entering organizer information, and a monitor for displaying organizer information (see col. 4, lines 23-49).

With respect to claim 3, Smith further discloses that the mobile device comprises a mobile handset (see col. 2, lines 13-16).

With respect to claim 4, Smith further discloses, as illustrated in Figures 3 and 16, the base station comprises a cradle for receiving the handset (see col. 3, lines 21-23).

With respect to claim 8, Smith further discloses that the mobile device further comprises a hinged cover located over the display screen (see FIG. 2. Col. 3, lines 61-66).

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 5, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Smith, II** as applied to claim 3 above, and further in view of **Henderson (6,035,214)**.

Regarding claim 5, Smith fail to specifically disclose that the cradle includes nodes for charging the handset and in which the nodes form part of the data transfer system. Henderson discloses a computer integrated with a telephone in which the telephone handset can be mounted in a cradle and the cradle include nodes for charging the handset and the nodes form part of the data transfer system (see col. 4, lines 18-35, FIG. 4). It would therefore have been obvious to one of ordinary skill in the art to combine the above teaching of Henderson with the system of Smith in order to provide a versatile portable personal information management device with increased power supply through continuous charging of local power sources such as batteries.

Regarding claims 6 and 7 Smith further discloses the use of an infra red transceiver for beaming information to and from other IR devices (see col. 2, lines 23-35), thus inherently suggesting the capability of transferring data using a radio frequency transmitter including antennae as being part of the data transfer system when other separately hand held devices such as a cellular telephone or a pager are used or attached with the media clip (see col. 2, lines 9-35).

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Smith, II** as applied to claim 8 above, and further in view of **Nguyen (5,797,089)**.

With respect to claim 9, Smith further discloses power management circuitry as illustrated in Figure 14, and electrical connector cabling included in the hinged connector 33 (see col. 5, lines 23-60), but fail to specifically disclose a switch operatively associated with the hinged cover for on-off control of the display screen. Nguyen teaches a personal communication terminal that inherently include a switch operatively associated with the hinged cover for on-off controlling the display screen (see col.4, lines 6-27). It would therefore have been obvious to one of ordinary skill in the art to incorporate the above teaching of Nguyen with the system of smith for the benefit controlling, managing and conserving power during selective operation of the communication apparatus.

8. Claims 10, 11, 13, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Nguyen (5,797,089)** in view of **Duncan et al. (5,825,873)**.

With respect to claim 10, Nguyen discloses a mobile communication handset (FIG. 1), the handset comprising a personal organizer unit (inherent feature of PDA unit 31 being able to

perform functions such as calculator, agenda, clock, notepad and editors, col. 5, lines 39-45), and a display screen (see col. 3, lines 64-65). Nguyen's teaching of the PDA unit being able to perform functions such as AGENDA, col. 5, line 41, read on organizer access and the availability of the PDA keyboard 24 reads on organizer data access keys (col. 4, lines 7-22), otherwise it would be obvious to one of ordinary skill in the art to have function keys available for easy access to the other functions of the PDA such as agenda, notepad and editors). Nguyen further discloses the capability of mobile data interface unit 34 being used to transfer data directly between the PDA unit and the telephone unit without the use of a modem (see, col. 4, lines 32-35), but fail to specifically disclose performing the organizer data transfer remotely from the base station to the organizer while the handset is remote from the base station. In a similar field of endeavor, Duncan discloses an interface for exchanging data between a host and an accessory item including remote implementation of the data path (see col. 2, lines 10-20, col. 7, lines 14-28). It would therefore have been obvious to one of ordinary skill in the art to incorporate the above teaching of Duncan with the system of Nguyen for the benefit of providing remote control capability for mobile device users as well as sharing information.

With respect to claim 11, Nguyen further discloses that the wireless telephone unit comprises an alphanumeric keypad (see col. 4, lines 7-8), and function keys (see SEND, END, PWR, RCL, STO, MENU, ALPHA, MEM of FIG. 1).

With respect to claim 13, Nguyen inherently discloses that the organizer comprises a display screen (feature of PDA unit 31 being able to perform functions such as calculator,

agenda, clock, notepad and editors, col. 5, lines 39-45), and also having a display screen (see col. 3, lines 64-65).

With respect to claim 14, Nguyen inherently discloses the organizer unit comprising a memory device and the personal organizer software being stored in the memory device (feature of PDA unit 31 being able to perform functions such as calculator, agenda, clock, notepad and editors, col. 5, lines 39-45) and the PDA unit including read only memory (ROM) for storing application programs, col.4, line 59 to col. 5, line 9).

With respect to claim 15, Nguyen further discloses (with reference to FIG. 3), a radio frequency unit (radio TX and radio RX), operatively connected to the memory device (ROM 41, RAM 42), but fail to specifically disclose it is for receiving digital organizer data. However, since Duncan discloses an interface for exchanging data between a host and an accessory item including remote implementation of the data path (see col. 2, lines 10-20, col. 7, lines 14-28), those of ordinary skill in the art would have appreciated combining the above teaching of Duncan with the system of Nguyen for the benefit of providing remote control capability for mobile device users including transferring or downloading any desired data.

9. Claims 12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Nguyen** and **Duncan et al** as applied to claim 10 above, and further in view of **Charlton (5,929,774)**.

With respect to claims 12 and 22, Nguyen as modified by Duncan fail to specifically an audible alert notification feature activatable from the base station and in which the audible alert notification feature is activated by a pre-scheduled event from the organizer data. In an analogous

field of endeavor, Charlton discloses a combination electronic pager, organizer and radio that includes an audible alert notification feature (alarm 66, FIG. 4) which is activated by a pre-scheduled event from the organizer data (see col. 5, lines 53-63, col. 6, lines 35-42). It would therefore have been obvious to one of ordinary skill in the art to combine the teaching of Charlton with the system of Nguyen and Duncan for the benefit of providing desired notification for scheduled events such as personal schedules or appointments.

10. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Smith, II (5,768,163)**.

Regarding claim 16, Smith discloses a communications and personal organizer method, that comprises the steps of:

inherently inputting organizer into a computer base station (feature of Smith's teaching of the display/write pad providing spontaneous use, by simplifying taking along bits of personal information such as appointments, phone number, notes and miscellaneous data files, col. 3, lines 44-49, and touchpad buttons functioning as softkeys for user input, col. 4, lines 48-49). Smith further teaches the media clip pad or other hand held device that can include an additional device which can be separately attached to the media clip pad (see col. 2, lines 13-16) and the convenience of separately operable hand held devices to be part of a portable computer or to be separate versatile stand-alone units (see col. 4, lines 31-35), which reads on a mobile handset separable from the computer base station, and further suggests the capability of beaming information to and from other infrared devices through an infrared transceiver of the hand held

device (see col. 2, lines 23-30, col. 6, lines 1-10) and using the handset for wireless telephone communication (feature of the hand held device being a cellular telephone (see col. 2, lines 13-16, col. 2, lines 65-67). Smith meets all the limitations of claim 16, except specifically disclosing transmitting organizer data including personal scheduling information from the computer base station. However, since Smith suggests using the display/write pad feature to take such bits of personal information as disclosed above as well as the capability to beam information and exchange information with other infrared devices, those of ordinary skill in the art would have appreciated being able to use Smith's invention to transfer any desired information including personal scheduling appointments, for the benefit of storing desired data such as personal organizing data for later retrieval and display when desired.

Regarding claim 17, Smith further discloses an alpha-numeric personal computer keypad (see col. 3, lines 38-49, col. 4, lines 25-28), thus anticipating the step of inherently inputting organizer data via a keyboard connected to the base station.

Regarding claim 18, Smith as modified further discloses the step of inherently transferring organizer data from the mobile handset (see col. 2, lines 23-30, col. 6, lines 1-10).

11. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Smith** as applied to claim 16 above, and further in view of **Henderson (6,035,214)**.

Regarding claim 19 and 20, Smith fails to specifically disclose that the transmitting step occurs while the handset is located in a cradle or removed from the cradle associated with said computer base station. In a similar field of endeavor Henderson discloses a computer integrated

with a telephone in which the the telephone handset can be mounted in (or removed from) a cradle and data exchanged over cordless or IR interface (see col. 3, line 66 to col. 4, line 35). It would therefore have been obvious to one of ordinary skill in the art to combine the above teaching of Henderson with the system of Smith for the benefit of ergonomically incorporating the telephone into the layout of the computer or personal digital assistant for integrated or modular operation as desired.

Regarding claim 21, Smith further inherently discloses retrieving the personal scheduling information from the personal organizer unit using function keys located on the mobile handset (feature of touchpad buttons functioning as softkeys for user input, see col. 4, lines 47-49).

12. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Smith, II (5,768,163)** in view of **Kaufman (6,034,621)**.

Regarding claim 16, Smith discloses a communications and personal organizer method, that comprises the steps of:

inherently inputting organizer into a computer base station (feature of Smith's teaching of the display/write pad providing spontaneous use, by simplifying taking along bits of personal information such as appointments, phone number, notes and miscellaneous data files, col. 3, lines 44-49, and touchpad buttons functioning as softkeys for user input, col. 4, lines 48-49). Smith further teaches the media clip pad or other hand held device that can include an additional device which can be separately attached to the media clip pad (see col. 2, lines 13-16) and the convenience of separately operable hand held devices to be part of a portable computer or to be

separate versatile stand-alone units (see col. 4, lines 31-35), which reads on a mobile handset separable from the computer base station, and further suggests the capability of beaming information to and from other infrared devices through an infrared transceiver of the hand held device (see col. 2, lines 23-30, col. 6, lines 1-10) and using the handset for wireless telephone communication (feature of the hand held device being a cellular telephone (see col. 2, lines 13-16, col. 2, lines 65-67). Smith meets all the limitations of claim 16, except specifically disclosing transmitting organizer data including personal scheduling information from the computer base station to a personal organizer unit which is separably located from the computer base station. which is . Kaufman teaches a system for wireless synchronization of data between a PC and a PDA (title) which includes synchronizing information relating to a scheduler program including personal information, contact information, etc., without using a fixed dedicated link between the PC and PDA (see col. 1, lines 25-39, col. 2, lines 47-67). It would therefore have been obvious to one of ordinary skill in the art to transfer any desired information including personal scheduling appointments, for the benefit of efficiently utilizing wireless communication for fast remote synchronization of data files including updating of storing desired data such as personal organizing data for later retrieval and display when desired.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McGregor et al. (5,577,100) teaches a mobile with a cradle for attachment to a personal computer.

Bernard (5,675,524)discloses a portable integrated communication apparatus.

Grube et al. (5,724,655) discloses the operation of multiple devices wirelessly.

Gilbert (6,067,583) discloses modular reconfigurable components with wireless data transfer.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Appiah whose telephone number is (703) 305-4772. The examiner can normally be reached on M-F from 7:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chang, can be reached on (703) 308-6739.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700. The Group fax numbers are (703) 308-6306 and (703) 308-6296.

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Serial Number: 09/353,316

CA

Charles Appiah

June 8, 2001.